

REMARKS

Summary of Amendments Made

Claim 1 has been amended to address the examiner's 35 U.S.C. 112, second paragraph rejection (support for this amendment can be found throughout the specification, e.g. page 5, lines 27-29).

35 U.S.C. 103(a) rejection

Claims 1-11 were rejected by the examiner as being obvious over Gers-Barlag et al. (U.S. Patent 5,725,844) in view of Intrioni (Cosm. Toiletries, Vol. 18, No. 3, (1997)) and Oshima et al. (U.S. Patent 6,197,282).

As the claims have been amended to be specifically directed toward Pickering emulsions, it is believed that the above rejection is rendered moot. Even if Gers-Barlag had been directed toward Pickering emulsions, the Intrioni and Oshima et al. references do not provide the motivation for making the substitutions to the Gers-Barlag et al. references as indicated by the examiner.

MPEP 2143 states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". Without more, merely repeating the specific teaching of Intrioni does not constitute a suggestion to modify the Gers-Barlag et al. reference but improper picking and choosing of elements. ("... 'Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.' see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

Moreover, the examiner is unclear that the Intrioni even teaches the element required to be combined with Gers-Barlag et al. ("examiner takes the view that the boron nitride used in Intrioni article may be the same type of boron nitride in the instant invention..."). MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Intrioni does not establish the use of amphiphilic boron nitrides or of the particle sizes claimed by the applicants.

Oshima et al. is relied upon to modify the Intrioni reference to provide an amphiphilic boron nitride. However, the ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000); not supposition. There is no indication that applying the coating method of Oshima et al. would render boron nitride amphiphilic (Oshima et al.'s process is directed toward metal oxides) nor is there any motivation for modifying the teaching of Intrioni from either the Intrioni or Oshima et al. references.

Therefore, it is believed that the examiner would be justified in withdrawing the rejection of claims 1-11 as the combination of Intrioni and Oshima et al. does not produce an amphiphilic boron nitride and even if a teaching of an amphiphilic boron nitride is established (or produced by alternative references) there is no motivation to substitute this teaching into the Gers-Barlag et al. reference (which in any event is not directed to a Pickering emulsion).

